

## **REMARKS**

### **PRESENT APPLICATION**

Claims 48 - 67 are now in this application. Claims 1 - 7 were deleted, without prejudice, in Applicant's "Response to April 9, 1997 Office Action." Claims 9 - 17 were deleted, without prejudice, in Applicant's "Preliminary Amendment and Response to Office Action of December 2, 1997 And To Communication From Examiner Dated July 21, 1998." Claims 18 - 30 were deleted in Applicant's "Response to Office Action of November 19, 1998." Claims 8, 31 - 47 have been deleted herein, without prejudice, in order assert certain other embodiments of the invention in preference thereto. Applicant respectfully traverses the Examiner's rejections with respect to each of Former Claims 8, 31 - 47, and asserts the right to seek such claims in subsequent amendment, re-examination or in any other application claiming priority from or through the pending application.. Reconsideration of the Examiner's rejections and of the claims, as amended, is respectfully requested.

### **RESPONSE TO OBJECTIONS**

Former Claim 45 was objected to as being dependent upon a rejected base claim (Page 6, Lines 25 - 27 of the Office Action). Applicant respectfully traverses the objection on the ground that the base claim as drafted is allowable. However, as Claim 45 has been canceled herein, Applicant asserts that such objection is obviated.

## RESPONSE TO REJECTIONS

### 35 U.S.C. § 103(a) Rejections

The Examiner has rejected Former Claims 31 - 47 under 35 U.S.C. § 103 as being unpatentable over the art of record. Former Claims 31 - 37 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,521,815 to Rose, Jr. in view of U.S. Patent No. 5,337,361 to Wang et al.. Former Claim 38 was rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,521,815 to Rose, Jr. in view of U.S. Patent No. 5,337,361 to Wang et al. and further in view of U.S. Patent No. 5,083,814 to Guinta et al. Former claims 42 - 43 and 46 - 47 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,521,815 to Rose, Jr. in view of U.S. Patent No. 5,083,814 to Guinta et al. Former Claim 44 was rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,521,815 to Rose, Jr. in view of U.S. Patent No. 5,083,814 to Guinta et al., and further in view of U.S. Patent No. 1,364,025 to Billings.

Applicant respectfully disagrees with the Examiner's rejections and traverses the same on the basis that the claims assert matter which is not taught, implied, suggested or made obvious over the art of record. Applicant respectfully further argues that the rejection of Former Claims 31 - 47 is obviated by cancellation, without prejudice, of the same. In order to expedite this case, however, Applicant sets forth remarks with respect to the patentability of the present claims, and responds to the Examiner's characterization of the teachings of the prior art of record in regard to Former Claims 31 - 47.

Summary of Prior Art Cited Against Canceled Claims 8 and 31 - 47

The Examiner cites four references as making one or more of Former Claims 31 - 47 obvious: (1) U.S. Patent No. 5,521,815 to Rose, Jr., (2) U.S. Patent No. 5,337,361 to Wang et al., (3) U.S. Patent No. 5,083,814 to Guinta et al., and (4) U.S. Patent No. 1,364,025 to Billings. A brief synopsis of each of the references follows:

(1). U.S. Patent No. 5,521,815 to Rose, Jr. discloses a uniform system for verifying and tracking articles of value, which are defined as items which generally are insured (See, e.g., Col. 6, Lines 55 - 57; Col. 8, lines 16 - 17; Col. 17, Lines 51 - 52). Articles of value are described as being items such as cars and boats ( See, e.g., Col. 5, Lines 32 - 33), which generally carry serial numbers placed thereon by the manufacturer, and items such as artwork and antiques and real estate, which generally do not carry serial numbers (See, e.g., Col. 17, Lines 20 - 21 and Line 31; Col. 5, Lines 33 - 36). The system issues title numbers and registration numbers identical in part to any serial number on such article of value (See, Col. 5, Lines 47 - 50). Using the Rose, Jr. system, a car is issued a permanent license plate which is coded to the VIN number (See, Col. 11, Lines 17 -20). Title is issued upon approval of a centralized authorized entity, and the title numbers and registration numbers are provided by the same (See, Col. 5, Lines 24 - 29). By tying the serial number (such as a VIN) with the title and registration number, the Rose, Jr. system attempts to make it easier to recognize false titles (See, Col. 9, 52 - 58). Once the title number and registration number are assigned, the centralized entity creates a title file in which information pertaining to important transactions pertaining to the article may be entered (See, Col. 7, Lines 14 - 19). Information pertaining to the item is sent by authorized agents (See, e.g., Col. 8, Lines 12 - 26) who may access the central database by providing an authorized entry code (See, e.g., Col. 11, Lines 48 - 52).

(2). United States Patent No. 5,337, 361 to Wang et al. discloses a record which contains a graphic image, and an information area, which are interrelated to discourage misuse of the record (See, Abstract). By interrelating the data and images, counterfeiting is reduced (See, e.g., Col. 1, Lines 35 - 42). Thus, for example, if a new photograph is inserted over an appropriate photograph, the information in the information area would not match the graphic image and counterfeiting would be detected (See, Col. 1, Lines 54 - 57).

(3). United States Patent No. 5,083,814 to Guinta et al. discloses an anti-theft security system for automotive, marine and other valuable personal articles such as objects of art and valuable collectibles (See, Abstract). In the Guinta et al. system, a dealer/installer first records and inputs data into a unit, such as a subscriber's name, address, description of article to be protected, manufacturer and serial number of the article, the insurance carrier providing insurance coverage on the article, etc. (Col. 2, Lines 5 - 8), then the unit, reading from memory a programmed set of possible marking locations for the particular type of article that has been entered (Col. 2, Lines 11 - 14), randomly selects a location from the pre-set programmed possible marking locations for a security marking to be applied (Col. 2, Lines 8 - 10) displaying such locations on a display screen (Col. 2, Lines 16 - 18) to the installer. The unit assigns the code which is to be placed on the article, which may be placed in an invisible manner. Once the security marking is applied, the subscriber information, registration code and the coordinates of the markings are transferred to a limited-access central data base and the memory of the unit at the dealer/installer is erased (Col. 2, Lines 30 - 45). In the case of theft, authorities are provided with the coordinates of all marked locations as well as the code printed on the article (Col. 3, Lines 16 - 21).

(4). U.S. Patent No. 1,364,025 to J. Billings discloses concealing an identification element by disguising it as part of a machine (See, Claim 1), such as

enclosing the identification element within the bolt of a machine (Col. 3, Lines 40 - 64, Claim 4).

#### The Examiner's Arguments

The Examiner has rejected Former Claims 31 - 37 as being obvious in light of U.S. Patent No. 5,521,815 to Rose, Jr., in view of U.S. Patent No. 5,337,361 to Wang et al.. Applicant respectfully traverses such rejection.

The Examiner argues that the Rose, Jr. reference "teaches a computer-assisted method of recording the identity of a purchaser of a particular good in a retail setting" comprising certain elements of Former Claims 31 - 37 (See, Page 2, Line 23 - Page 3, Line 6). The Examiner acknowledges that the Rose, Jr. reference doesn't "clearly teach 'accepting from a purchaser of said good an identity card housing electronically readable personal identification information'" (Page 3, Lines 16 - 17 of the Office Action). However, the Examiner argues that the failure of the Rose, Jr. reference to teach an identity card housing electronically readable personal identification information is overcome by the Wang et al. reference which he states teaches "an identity card (drivers license) that is encoded with electronically readable personal identification information" (Page 3, Lines 8 - 10 of the Office Action). The Examiner asserts that "it would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide a bar code reader at an auto dealer seeking to implement the Rose invention in order to read bar coded information on the drivers license in order to increase security" (Page 3, Lines 11 - 14).

The Examiner summarizes his position with respect to Former Claims 31 - 37 as: "[ (1) ] Rose teaches the features of the invention, without extolling the benefits of automatic entry of data using machine readable codes[,] [ (2) ] Wang extols the benefits of automatic entry of just the type of data that is being entered in the Rose reference[,] [ (3) ]

[I]t would have been obvious to apply the Wang teachings to Rose” (Page 5, Lines 18 - 21 of the Office Action). Arguing that the Rose et al. reference teaches placing the Rose et al. license plate onto a car before retail sale, “[s]ince the VIN is ordinarily assigned to the car at the time of manufacture, and since the license plate [of Rose et al.] is directly related to the VIN” (Page 6, Lines 4 - 7 of the Office Action), and asserting that the Rose, Jr. reference teaches the “fundamental idea of matching product with customer at the time of retail purchase” (Pages 5, Line 29 - Page 6, Lines 2 of the Office Action), the Examiner asserts that the Former Claims 31 - 37 are obvious in light of the prior art.

With respect to Former Claims 34 and 35, both of which ultimately depend on Former Claim 31, the Examiner asserts that “electronically-readable coded form” includes alpha-numeric printing (Page 3, Lines, 20 - 22; Page 6, Lines 11 - 14 of the Office Action). The Examiner also asserts with respect to Former Claims 22 (sic - 45?) and 47 that a lot number is functional equivalent subset of an automotive VIN number (Page 3, Lines 23 - 25 of the Office Action) and relates to the origin of manufacture (Page 4, Lines 16 - 17 of the Office Action).

The Examiner rejected Former Claim 38 under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,521,361 to Rose, Jr. in view of U.S. Patent No. 5,337,361 to Wang et al. and further in view of U.S. Patent No. 5,083,814 to Guinta et al.. Similarly, Former Claims 42 - 43 and 46 - 47 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,521,361 to Rose, Jr. in view of U.S. Patent No. 5,083,814 to Guinta et al.. The Examiner asserts that the teaching of the Guinta et al. reference of an invisible identifier makes it obvious “to conceal the identification of Rose using an invisible marking ... in order to further thwart theft by preventing thieves from erasing the identification number” (Page 4, Lines 11 - 14 of the Office Action).

In regard to the Examiner’s rejection of Former Claim 44 under 35 U.S.C. § 103, the Examiner, maintaining that the claim is unpatentable over U.S. Patent No.

5,521,361 to Rose, Jr. in view of U.S. Patent No. 5,083,814 to Guinta et al. and further in view of U.S. Patent No. 1,364,025 to Billings, asserts that the Billings reference teaches “the encoding of an owner good identifier below the surface of a material” and that “[it] would have been obvious at the time the invention was made to a person having ordinary skill in the art to conceal the identification of Rose and Guinta below the surface of the material ... to further thwart theft by preventing the thieves from finding and erasing the identification number” (Page 4, Lines 23 - 26 of the Office Action.

#### Applicant's Response

Applicant traverses the Examiner's rejections and disputes the basis upon which they are based. Respectfully, Applicant asserts that the Examiner, using hindsight reconstruction and a predisposed desideratum, ignores the specific limitations and the totality of teachings of the prior art, while inappropriately construing the claims of the present application to reach the Examiner's desired objective – that is, to find the invention obvious.

Applicant in particular notes NO teaching, suggestion or implication that the bar code on the license plate described in the Rose Jr. reference was to be used in the manner described in the present invention, never mind in the registration system described in the Rose, Jr. reference. The Rose Jr. “bar code” is added to the license plate because “the title number is too long to place on the article itself” (See, Col. 5, Lines 49 - 55). The bar code simply acts to allow “the complete title number [to] be affixed to [the] registration plate” (Col. 5, Lines 55- 57), as reinforced by the teaching that “the bar code may be replaced with a hologram” (Col. 9, lines 41 -42).

Applicant notes in the description of Figs. 1A - 1H (Cols. 11 - 14) of the Rose Jr. reference that the process is said to begin with the transmission of the “VIN” (Col. 11, Line 66), not the “title number” which is coded by the bar code on the Rose, Jr.

license plate. Applicant remarks that the title number of the Rose Jr. reference is said to be identical to the VIN number "plus the original state of entry, origin or titling"(emphasis added) (See, Col. 5, Lines 46 - 49). Therefore, the bar code is not used to begin the registration process described in the Rose Jr. reference, contrary to the Examiner's suggestions otherwise. Applicant also notes that on resale of the motor vehicle, the Rose, Jr. reference suggests that a title card, not the license plate, is used in the recordation process of the new owner, with the title identification card being "submitted to the authorized agent upon transfer so that title may be updated to reflect relevant data on the new owner, any changes in the condition of the article" (Col. 7, Lines 45 - 48) (See, also, Col. 10, Lines 46 - 49). In short, the Rose Jr. reference simply does not contemplate, nor does it teach or suggest, using the bar code on the license plate in a registration process.

Applicant further disagrees with the Examiner that the Rose , Jr. reference teaches placing the license plate onto a car before retail sale (Page 6, Lines 4 - 7 of the Office Action). Applicant notes again the description set forth with regard to Figs. 1A - H (Cols. 11 - 14) wherein it is noted that the along with the input of the VIN to begin the process that other data may also be input, such as data on the owner (Col. 11, Line 66 - Col. 12, Line 4), which of course would not ordinarily be known prior to retail sale. Further, Applicant notes Col. 16, Lines 17 - 25 wherein permanent registration plates are said to issue after the new title information is transmitted and the original certified title is printed, both of which occur after sale. Similarly, Applicant notes that the license plate depicted in Fig. 3 of the Rose, Jr. reference is described as including state information (Col. 9, Lines 36 - 38). Again, such information would not ordinarily be known prior to retail sale (Applicant ponders what would happen if a car was shipped with a license plate with state information attached thereto, and then the car was shipped to another state because no sale was made in the state to which it was originally shipped.). In conclusion, Examiner's suggestion that the license plate is placed on the car before retail sale is just not supported by the teachings of the reference.



Applicant remarks that Former Claims 31 - 38, as well as New Claim 48, require that the encoded good be accepted from the purchaser at retail sale. The Examiner suggests that tender of the good by the purchaser is taught by the Rose, Jr. reference (Page 2, Line 25 of the Office Action). Applicant respectfully asserts that such suggestion is simply without merit. Applicant notes no disclosure in the reference with respect to the purchaser proffering the vehicle. Nor can Applicant conceive of any practical scenario wherein a purchaser of a vehicle would drive the vehicle desired to be purchased to the show room to record the title number bar code along with purchaser identification information from an electronically-readable identity card. Respectfully, such scenario simply does not make any sense, especially since the car dealer would already have the VIN number upon numerous documents which are normally supplied upon receipt of the car by the dealer from the manufacturer.

Applicant further notes no teaching in the Rose, Jr. reference of an identifier identifying the type of good. If anything, the Rose, Jr. reference implies that such information is not needed. Applicant notes that the Rose, Jr. process uses serial numbers which are already assigned by the manufacturer, or in the case of a vehicle the VIN number (See, Col. 5, Lines 36 - 45) in its registration process. There is no teaching that any code placed on an article (See, Col. 1, Lines 28 - 31) be useful in identifying the type of good (such as whether the item to which the identifier is attached is a picture, lawn chair, mower, etc.). This is in contradiction to the embodiments asserted in Former Claims 31 - 38 and New Claims 48 - 54. Respectfully, the coding system of the Rose, Jr. reference simply would not be useful in the present invention.

Applicant also respectfully asserts that the Examiner is unfairly contorting the reading of the phrase "electronically-readable coded form," in suggesting that such phrase "does not exclude alpha-numeric printing" (Page 6, Lines 11 - 12 of the Office Action). Applicant disagrees that a person of ordinary skill in the art would interpret

“coded” form as implying standard alpha-numeric printing. While disagreeing with the Examiner, Applicant has set forth a definition in the amended specification which clearly demonstrates that such term does not imply alpha-numeric printing : “By ‘electronically-readable coded form’ it is meant data stored on or in magnetic form, electrical form, digital form (including storage on an optical disk), or symbolic print (that is, print symbolic of full text, without recourse to characters of conventional international languages and/or numerics, such as Arabic numerals, Roman numerals, English language characters, Chinese language characters, Japanese language characters, Russian language characters, etc.) which is capable of being read by an electro-optical reader.”

In regard to a “package” enclosing the good, while Applicant believes the meaning of “package” is well known to persons of ordinary skill in the art, Applicant has defined the term in the amended specification in a manner asserted to comport with that understanding: “by ‘package’ it is meant a covering which substantially surrounds a product to protect the product from damage prior to end-consumer use and which does not form part of the product itself. Clearly, the license plate of Rose, Jr. does not meet the definition of a “package”.

With respect to the Wang et al. reference, Applicant notes that the reference describes many types of records, for example, a passport, visa, ticket, bearer bond, stock certificate, picture. license or other record - See, e.g., Col. 1, Lines 14 -34. The reference also teaches a myriad of types of information which the scannable information is disclosed to comprise (Applicant notes Col. 4, Lines 7 - 41, referencing licenses, wherein the information is said to optionally include: whether the owner of the driver’s license was authorized to drive without corrective lenses, data on the eye color, hair color, sex, and/or height and weight of the holder of the license, or may consist of faceprint, correlatable with certain relations in the face). By picking and choosing from a broad disclosure, disclosing numerous kinds of records and encoded information types, the Examiner discovers a particular identity card housing electronically-readable

personal identification information for combination with select and misconstrued “teachings” of the Rose, Jr. reference. In attempting to construct the disclosed invention, respectfully, the Examiner combines two disparate references, one having an object “to provide a record with a graphic image along with encoded information to validate or authenticate a record” (See, Col. 2, lines 13 - 15 of Wang et al.), the other having an object of effecting a universal, uniform system for tracking transaction for items of value (See, Col. 1, Lines 11 - 13 of Rose, Jr.).

Applicant respectfully asserts that the Examiner is using impermissible hindsight, in picking and contorting certain isolated elements from the Rose, Jr. reference, while ignoring numerous disclosures and teachings in the same reference which are contrary to the present invention, and in selecting isolated elements from several laundry lists set forth in the Wang et al. reference without any direction to do the same. Respectfully, the Examiner is using a magician’s illusion to construct what can be described at best as a phantom approximation of the present invention, using a slight of hand that fails to provide a compelling, or even plausible, motivation for combining and altering the references in the manner described.

Former Claims 42 - 43 and 46 - 47 were rejected by the Examiner as being unpatentable over U.S. Patent No. 5,521,361 to Rose, Jr. in view of U.S. Patent No. 5,083,814 to Guinta et al. The Examiner acknowledges that the Rose, Jr. reference “does not teach the use of an invisible good identifier” (Page 4, Lines 10 -11 of the Office Action). The Examiner argues that the Guinta et al. reference “teaches the use of an invisible good identifier” and that it “would have been obvious at the time the invention was made to a person having ordinary skill in the art to conceal the identification of Rose using an invisible marking as taught by Guinta et al. in order to further thwart theft by preventing the thieves from erasing the identification number” (Page 4, Lines 11 - 14 of the Office Action). Again, Applicant respectfully asserts that the Examiner misses the mark.

Applicant does not disagree that the idea of concealing a marking is old, but rather argues that the specific method and process claimed in Former Claims 42 - 47 and New Claims 55 - 57 and 59, and the product thereof ( which is asserted in New Claim 58), are novel and unobvious. The fact is that the process of New Independent Claim 55 eventuates in a product which permits rapid registration of purchaser identity with respect to numerous purchased goods while limiting access to the unique identifier which identifies the product. It is the combination of these functionalities that are asserted to be novel, not the idea of using an invisible marking. Thus, while the idea of concealing serial numbers from thieves may be an old one, such as shown in the Guinta et al. reference, neither the Guinta reference, Billings reference, the Wang et al. reference nor the Rose, Jr. reference suggest employing such concealment along with a package identifier as presently claimed. Nor has the Examiner cited a motivation to do so without reference to the teachings of the present application.

Applicant further disagrees with the Examiner that Former Claim 44 is made obvious by the Rose, Jr. reference in view of U.S. Patent No. 5,083,814 to Guinta et al. and further in view of U.S. Patent No. 1,364,025 to Billings. Applicant notes that the Billings reference teaches disguising an identification means (such as a tag) as part of a machine (See, Claim 1; Col. 2, Lines 98 - 109). It does NOT, contrary to the Examiner's suggestion otherwise, suggest encoding the good identifier below the surface of a material comprising the good, as required by Former Claim 44. Again, Applicant respectfully suggests that the Examiner is reading the disclosure of the Billings reference in a contorted manner to make it fit certain limitations of the present claims. Applicant respectfully requests that the Examiner give appropriate consideration to this limitation, shown no where in the art of record, in examining New Claim 56.

Lastly, Applicant disagrees with the Examiner in regard to Former Claims 22 (sic -- 45?) and 47 that a lot number is a functional equivalent of other numbers set

forth in the Rose, Jr. reference or other references of record (See, Page 3, Lines 23 - 25 and Page 4, Lines 16 - 17 of the Office Action). Applicant does not discern any character in the VIN which corresponds to a lot number. Nor does Applicant note any other reference of record which cites an identifier wherein the position of the identifier on the good is associated with the lot in which the good was manufactured (as asserted in New Claim 57).

#### Allowable Subject Matter

The Examiner has indicated that Claim 8 is allowable. Former Claim 8 is now incorporated as New Claim 66. Applicant, therefore, respectfully asserts that New Claim 66 is allowable.

#### New Claims

Support for the New Claims is found throughout the specification among other places at pages 20 - 25. The New Claims are asserted to be clearly patentable over the prior art.

### **CONCLUSIONS**

For all of the above reasons, it is submitted that the present claims are clearly patentable over the art of record. Applicant respectfully disagrees with the Examiner that Applicant's approach is that of "analyzing the finer details of the respective disclosures" without addressing "the Examiner's more basic view of the claims presented and the prior art teachings" (Page 5, Lines 6 -8 of the Office Action). Instead, Applicant respectfully asserts that it is the Examiner's "basic view" that is flawed. Applicant respectfully asserts that the Examiner is confusing the obviousness of solving a puzzle in the light of day (i.e., in the light of the Applicant's disclosure), with that of solving the same puzzle in the dark of night (i.e., without knowledge of the

present disclosure). It is Applicant's position that it is the latter by which "obviousness" of an invention should be judged not the former, no matter how complex, or un-complex, an invention may at face value appear.

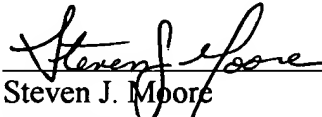
Accordingly, it is respectfully submitted that the claims under consideration are clearly patentable over the references of record. It is submitted that the above-identified patent application is in condition for allowance. Early notification of the allowability of Claims 48 - 67 is courteously solicited.

**FEES**

A filing fee of \$ 458 is enclosed to cover five independent claims (two claims in excess of three) and the filing fee for the continuation-in-part application.

Respectfully submitted,

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Steven J. Moore  
Applicant